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10/800,796	03/15/2004	Mark G. O'Donnell	ODONNELL.7374	9194

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EXAMINER

BRINSON, PATRICK F

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/800,796
Filing Date: March 15, 2004
Appellant(s): O'DONNELL ET AL.

MAILED
DEC 20 2006
GROUP 3700

William E. Hilton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 20, 2006 appealing from the Office action mailed April 25, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Declarations as listed in the Appeal Brief

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 38, 40-43, 46 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 1,435,311 to **Knight**.

The patent to **Knight** discloses a flexible tubular clamping jacket, having an elongated protector length that is adapted to be readily applied to the cores of different sizes and characters, with the cores having a protected length the same as the protector length. The jacket functions to protect cylindrical objects about which it is placed. The jacket is a single layer of abrasion resistant material, formed of rubber

tubing or similar elastomeric materials and is split length wise, with its edges being possessed of a strong, inherent, inwardly coiling or rolling and gripping tendency, thus allowing it to accommodate itself to cores of different diameters. Col. 2, lines 89-92, discloses that in some cases where the core is not large enough to expand the tube to its maximum capacity the edges (11 and 13) will overlap each other, as illustrated in fig. 3 and still grip and bind the core. The device of **Knight** has the same structure as the recited invention with the exception of not explicitly illustrating the jacket providing a plurality of overlapping layers to completely envelope a core once a force is provided that is greater than the gripping force. Fig. 1 discloses the jacket with an overlap that is substantially greater than that shown in fig. 3, yet there is still space provided within as shown by opening to accommodate a member. The difference between the jacket of **Knight** and the present invention is a function of size. If a rope or webbing smaller than the size of the tubing shown in fig. 1 were placed within the jacket, i.e., if a rope or webbing having an outer diameter substantially the same size as the opening shown in fig. 1 were placed within the jacket of **Knight**, the jacket would provide, in use, sufficient overlap of the rope or webbing to completely envelop it from damage once the edge (13) is lifted by a force stronger than that which makes it coil inwardly. Likewise, the jacket itself could be formed including greater width, which would accommodate cores of even greater diameter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the jacket of

Knight, increasing its width in order to accommodate a larger diameter core so as to provide a plurality of overlapping wraps to completely envelope and protect the core once the edge of the outer overlapping wrap is forced opened, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. As to the recitation of the jacket sliding sideways along a rough, hard surface, **Knight** does not disclose the jacket as being utilized in such an environment, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. In regard to claims 40, 41 and 46, the patent to **Knight** does not specifically disclose the inner diameter of the protector, nor its weight. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the protector to have a inner diameter of 0.8 cm or no more than 2.5 cm and to have a weight of less than 2.5 ounces because Applicant has not disclosed that having a diameter of no more than 0.8 cm and a weight of less than 2.5 ounces provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well as disclosed without specific mention of diameter and weight as it is disclosed that the diameter will vary depending on the diameter of

the core placed within it and it would not appear that the weight of the device is such as to prevent it from being easily packaged. Therefore, it would have been an obvious matter of design choice to modify the device of **Knight** to obtain the invention as specified in claims 40, 41 and 46.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of U.S. 4,929,478 to **Conaghan et al.**

The patent to **Knight** discloses the recited subject matter, but does not disclose the protector formed into square or triangular spiral shapes. The patent to **Conaghan et al.** discloses a protective sleeve for pipe or wires. Col. 4, lines 67-68 and col. 5, lines 1-4 disclose that although tubular articles having substantially cylindrical cross-section are illustrated in the drawings, other cross sections, including rectangular, square, or triangular may be set into the fabric by the use of dies or mandrels of the desired shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cross section of the sleeve of **Knight** to not only have a circular cross-section, but a square or a triangular cross section, as suggested by **Conaghan et al.** in order to accommodate cores having a triangular or square shaped cross-section.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of U.S. 4,181,157 to **DeCamp**.

The patent to **Knight** discloses the invention as discussed in the preceding paragraph with the exception of disclosing the material from which it is made as being a heat settable material. The patent to **DeCamp** discloses a sleeve formed of a flexible, heat settable material that is wrapped around itself, as well as the core upon which it's placed at least one and a half times. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the material of which the sleeve of **Knight** is made to be formed of a heat settable material as an alternative material since both **Knight** and **DeCamp** disclose rubber materials that are both self-coiling to protect a cylindrical core.

Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of **Whittington**.

The patent to **Knight** does not disclose the protector as being formed from urethane. The patent to **Whittington** discloses a protective wrapping for an elongated member, wherein col. 3, lines 28 and 29 disclose that one suitable material for the wrapping is urethane rubber. This wrapping, once placed on a mold or mandrel is subjected to heat and pressure to cure or vulcanize the rubber layers, thus producing a wrapping having great resistance to radially outward deformation, and

providing cushioning and protection from outside wear and abuse. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the rubber of **Knight**, a urethane material, as suggested by **Whittington** in order to produce a protector that will provide a cushioning for the protected member, and will prevent wear and abuse from the outside environment.

(10) Response to Argument

Applicant, in his remarks, as well as in the declaration of Richard F. Grossman, basically state that the invention of **Knight** cannot perform as it states it can.

Applicant states that the **Knight** reference appears to show in fig. 1 a device with an overlap, but further states that Applicant disagrees how the **Knight** reference teaches or discloses how such a device might be formed, and that it is not all clear how one might produce a device that provides such an inherent coiling or rolling action.

Applicant's remarks and declaration dispute that **Knight** device, being formed or a rubber or rubber compound can indeed provide an "inherent coiling or rolling action". However, in the application, how the device is formed is not an issue, as the claims of the invention are not drawn to a method of manufacturing of the protector, but instead are drawn to the protector itself and the method of protecting an elongated device, in this case, a rope. **Knight** does disclose a self-coiling rubber sheet that may be pulled opened to provide access to its inside and allow a circular, elongated device, like a rope therein to be protected. In regard to the 2nd declaration

by Mark O'Donnell stating the commercial success of the protector, it should be noted, that the idea of providing an abrasion resistant, self-coiling material is not novel, wherein cited references such as U.S. 2,053,811 to **Boyle** and U.S. 2,826,523 to **Blaszkowski et al.** both disclose protective, self-coiling abrasion resistant materials. Though not specifically utilized with ropes, they, along with the **Knight** reference teach that it is known and old to provide a self-coiling material that may be forced opened to provide an elongated member for the protection of that member. The self-coiling action provides sufficient gripping force as to inhibit slippage along the length of the rope when not external force is applied to the protector.

The declaration of Mark O'Donnell fails to establish that the device alleged to provide the commercial success/long felt need is the claimed invention of the instant application. Declarations not relating to the specifics of the claimed invention are not persuasive. Evidence of commercial success/long felt need must be commensurate in scope with the scope of the claims.

The declaration, as it pertains to long felt need, fails to establish if other attempts to improve on or solve problems with rope protection, if any, were made. Further, if other attempts have been made, what were they, and were such failures due to lack of interest or appreciation of an invention's potential or marketability rather than want of technical know-how, etc.

The declaration, as it pertains to commercial success, fails to establish that the alleged commercial success is derived directly from the invention claimed. In a marketplace where the consumer is free to choose on the basis of objective principles such success may be the result of heavy promotion or advertising, a shift in advertising, preferential exposure in the marketplace, discounts for promotional purposes, fancy packaging, or other business events extraneous to the merits of the claimed invention, etc. To establish commercial success, a link or nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight en route to a conclusion of the obviousness issue.

The declaration must set forth facts, not mere conclusions, and the facts must be pertinent to the rejection.

Therefore, having considered the factual inquiries specified in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), and the factual allegations in the applicant's declaration in accordance with the provision of 37 CFR 1.132, the rejections are deemed proper for the reasons set forth above and in the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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P. F. Brinson

Conferees:


K.S.


J.H.